

inflatable structure." (Final Action page 2, lines 12-14). It is noted that the term "flaccid material" is not used in Roehr. The possibility that the plastic foil may indeed comprise "flaccid material" does not establish that the plastic foil is flaccid material. The mere fact that a "flaccid material" *may* result from the selection of plastic foil is not sufficient to establish that the plastic foil described in Roehr is flaccid material. Indeed, it is also possible that the plastic material may not be flaccid and may retain a predetermined shape before and after the introduction of air into Roehr's apparatus. This is suggested, for example, by the various structures and uses set forth in Roehr's description at page 4, lines 4-11 (of the translation). Roehr's disclosure is therefore insufficient to show that the natural result flowing from the use of plastic foil would produce "an inflatable structure comprising the overlaying sheet and the base sheet . . .". Inherency may not be established by probabilities or possibilities. *In re Oelrich and Divigard*, 212 U.S.P.Q. 323 (CCPA 1981).

The "inflatable structure comprising the overlaying sheet and the base sheet . . ." is positively recited in Claim 20 and is not disclosed by Roehr. This structural feature is further limited in lines 15 and 16 of Claim 20 as follows:

" . . . whereby, the opening, the inflatable structure, and the apertures allow air to inflate the thermal blanket and to be exhausted from the thermal blanket."

With attention to Figs. 1 and 2 of Roehr, it is noted that the air exit openings 25 are large, having almost the same dimensions as the punctual welded or glued sections 41 and 42. In contrast, the apertures 62 in the base sheet of Claim 20 are shown in Fig. 5 to be very small; in the specification an exemplary size is "approximately 1/4 inch in length." (Specification, page 14, line 3). Large air exit openings such as those shown by Roehr would so deplete pressure within Roehr's structure as to make it difficult to inflate, if indeed it is inflatable. For this reason also it is possible that Roehr's plastic foil retains a self-supporting, non-inflatable structure. In this regard, Roehr's device would operate much as Wales'.

Therefore, while it is possible that Roehr's structure does include a flaccid material and that the flaccid material makes the structure inflatable, it is also possible that Roehr's structure is like that of Wales, which is non-inflatable. Accordingly, without a

characterization of the plastic foil in a way that Roehr omits, this reference does not contain a positive or inherent recitation of "an inflatable structure comprising the overlaying sheet and the base sheet . . .".

With respect to the fabric-lined foil disclosed by Roehr, the Examiner contends that "Roehr discloses a single layer of fabric lined foil, not two separate layers." It is noted that Roehr *describes* a double-walled cover having two layers, with the layers "consisting of weldable plastic foil or a fabric lined with plastic foil . . .". In the figures, the layers 11, 111 are illustrated schematically as single lines in Fig. 2. The schema merely show the location of the layers, not their structural details. In contrast, Figs. 3 and 4 of this application clearly show the laminate structure of the base sheet. Roehr contains no such illustration.

The term "fabric lined foil" admits the *possibility* that one or more layers of Roehr is laminated. However, it is also possible that the fabric-lined layer could be lined in way that a pair of trousers is lined: by a single seam at the periphery of two sheets that may or may not be closed and may or may not be continuous. Such a lining does not produce a "laminate" structure. Again the inherency of lamination is not established by probabilities or possibilities.

Accordingly, for the failure to teach an inflatable thermal blanket that comprises "a laminate base sheet . . ." and "an inflatable structure comprising the overlaying sheet and the base sheet . . .", Roehr does not anticipate Claims 20-22, 34 and 35.

Furthermore with respect to Claim 35, it is observed that Roehr does not include a "non-inflatable recess near a first end" of the described apparatus. Therefore, for this additional reason, Roehr does not anticipate Claim 35.

Claims 23, and 25-31 have been rejected for obviousness over Roehr. That rejection is traversed for the reasons given in the response dated 3 April 1998, and for the following additional reasons.

Hospital bedding is normally *reusable*, not disposable. Normally, in a hospital setting, things like needles and bandages are disposable. Accordingly, the Examiner is respectfully requested to submit a reference or to take judicial notice of the motivation of "disposability" in the selection of materials for the lower base sheet in the rejected claims.

Second, the Examiner does have the burden of showing why paper is an obvious selection for "the fibrous material". A general incentive does not make obvious a particular result. In this case, since hospital bedding is more likely to be reusable than disposable, there is not even a general incentive to make paper an obvious choice for "the fibrous material". Finally, the Examiner proposes, as motivation for selecting paper, the fact that "paper is well known as the most common disposable substitute for cloth (e.g. towels, sheets, robes etc.) . . . ". This is speculation, unsupported by any reference or notice in the record. It is respectfully submitted that air is the most common disposable substitute for towels; paper sheets are a curiosity probably not much loved by those disposed to lay on them, and therefore are an unlikely substitute for cloth sheets; and one is more likely to be offered a synthetic robe as a substitute for a cloth one than a paper robe.

Regarding the "comfort" factor of the base sheet, Roehr's description makes it equally likely that plastic would face the skin of the user as any other material used to construct Roehr's apparatus. In this regard it is noted that Roehr states that the layers may consist of "weldable plastic foil or of a fabric lined with plastic foil . . . ". (Roehr translation, page 3, lines 5, 6). In other words, it is equally likely that Roehr's device would be all plastic as any other combination of materials. In this case, a plastic foil would face the skin of a user. To impute any particular combination of materials *and* a particular orientation of the chosen materials is speculative and reflects hindsight.

Accordingly, the Examiner is respectfully requested to withdraw this rejection.

Claims 32 and 33 have been rejected over Augustine '188 in view of Roehr. That rejection is traversed for the reasons given in the Amendment submitted 3 April 1998.

The Examiner has rejected Claim 36 for obviousness over Roehr in view of Hardy. That rejection is traversed for the reasons given in the Amendment of 3 April 1998 and for the following reasons.

The applicant respectfully submits that the Examiner still has not satisfied all of the elements of *prima facie* obviousness. Furthermore, a motivation must be found to amend Roehr's device with Hardy's shape. The motivation is not in Roehr, who describes a device with manifold uses and structures, but who does not describe a need to observe. Neither does

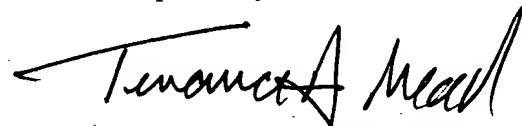
Roehr describe a need to accommodate the peripheral shape of his device to the contour of a body. Hardy's contour is not defined "by a seal". Neither device is taught as being inflatable.

The Examiner has rejected Claims 37-39 for obviousness over Augustine, Roehr, and Hardy. That rejection is traversed for the reasons given previously.

The '656 patent was submitted as evidence that Roehr is non-enabling with respect to Claims 20-22., 34 and 35. The argument may have been inartfully stated, if so, any inconvenience to the Examiner is regretted.

In view of the remarks made in this paper it is submitted that all claims are patentably distinguishable from the references of records, early notice of which is earnestly solicited.

Respectfully submitted,



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